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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,316	02/19/2004	David K. Swanson	03-0285 (US01	2158

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EXAMINER

JOHNSON III, HENRY M

ART UNIT	PAPER NUMBER
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3739

MAIL DATE	DELIVERY MODE
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07/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,316

Applicant(s)

SWANSON ET AL.

Examiner

Henry M. Johnson, III

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 and 44 is/are rejected.
- 7) ☒ Claim(s) 43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Response to Arguments

Applicant's arguments filed January 22, 2007 with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

The Election/Restriction requirement required by the previous examiner is determined to have been improper; therefore, the claims are rejoined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 42 cites multiple outlets, yet the base claims cites a single outlet.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3739

Claims 1-11, 13-27 and 29-38 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,849,075 to Bertolero. Bertolero et al. teach a device for holding an ablation (electrophysiology) device including a trough (Fig. 4a, # 420) wherein the ablation member (Fig.

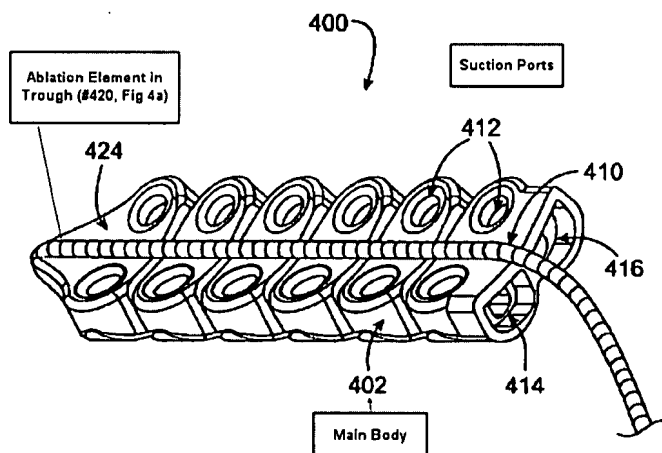


FIG. 4

4, # 410) may be a removable piece which may be removably attached to tissue contacting member (Fig. 4, # 402), at least partially disposed within a trough (Col. 16, lines 44-54). The ablation element is interpreted as an operative element. Multiple suction ports (Fig. 4, # 412) are disclosed, the area with the ports is interpreted as a bottom surface. The

ports are clearly longitudinally spaced. The trough is interpreted as a connector. The area around the ports can be interpreted as a wall and the bottom area is broadly interpreted as a suction region. Some means is required to connect the suction ports to the suction lumen, such connection interpreted as an aperture. The suction lumens are connected to a suction source via suction lines (Fig 6). The tissue contacting member is of a flexible material (Col. 16, line 3), implicitly making the suction apertures flexible and the trough (connector) flexible. Bertolero et al. disclose cooling of the ablation device by a cooling member with fluid inlets and outlets that allow passage of fluids from the ablation device, the ablation device inherently must have complementary lumens and fluid outlets to allow such passage (Claim 71). That passage would be within the connection trough.

Claims 39, 41, 42 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication US 2002/0002372 to Jahns et al. Jahns et al. teaches a

Art Unit: 3739

device with ablating elements (Fig. 2, # 22) that may include fluid ports (Fig. 2, # 46) or may be porous for the delivery of liquids (paragraph 0047). The fluid is disclosed as cooling the electrode (paragraph 0051). A lumen is inherent. The device teaches suction ports (Fig. 2, # 44) with suction openings (Fig. 2, # 54) that are coupled to a suction line and source. The method of use is inherent in the structure wherein the device uses suction to attach to a target tissue and the electrodes ablate lesions in the tissue. The cooling fluid is provided and the ports are disclosed as being directed towards the suction ports (paragraph 0053) making removal thereby inherently taught.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,849,075 to Bertolero et al. The amount of electrode extending below the support device is no discloses a critical and is considered an obvious design choice to a skilled artisan.

Art Unit: 3739

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication US 2002/0002372 to Jahns et al. as applied to claim 39 above and further in view of U.S. Patent 6,849,075 to Bertolero et al. Jahns et al. are discussed above, but do not teach the electrode removably attached with an interference fit. Bertolero et al. teach a removable electrode in a trough. A skilled artisan would recognize interference fit as suitable for such attachments are well known for easily removable elements. It would have been obvious to one skilled in the art to include the removable electrode as taught by Bertolero et al. in the invention of Jahns et al. as both are directed to similar uses and a skilled artisan would be motivated to seek such related art.

Allowable Subject Matter

Claim 43 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

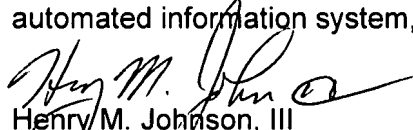
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Henry M. Johnson, III
Primary Examiner
Art Unit 3739